

REMARKS/ARGUMENTS

The Applicant originally submitted Claims 1-22 in the application. Previously, in an election requirement, Claims 1, 3, 5-7, 9, 11, 14, 16, 18 and 21 were elected and Claims 2, 4, 8, 10, 12-13, 15, 17, 19-20 and 22 were withdrawn. In the present response, the Applicant has not amended, canceled, or added any claims. Accordingly, Claims 1, 3, 5-7, 9, 11, 14, 16, 18 and 21 are currently pending in the application.

I. Rejection of Claim 1, 3, and 5-7 under 35 U.S.C. §103

The Examiner has rejected Claim 1, 3, and 5-7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,936,786 to Go (hereinafter "Go") in view of U.S. Patent No. 5,877,906 to Nagasawa, *et al.* (hereinafter "Nagasawa"). The Applicant respectfully disagrees since there is no suggestion or motivation to modify Go with the cited portions of Nagasawa.

The Examiner recognizes that "claim 1 differs from Go in that the claim further requires the said deactivation occurring at or about the time of occurrence of said detection of said pre-existing signal." To cure this deficiency of Go, the Examiner cites portions of Nagasawa. Go teaches an apparatus and method to protect information recorded on a recording medium by determining blank portions of the recording medium for recordation of new information. To accomplish this, Go teaches scanning an entire medium and detecting the presence of a control pulse which corresponds to a recorded portion of the medium and determining a portion of the recording medium where a control pulse is not detected which corresponds to an unrecorded portion of the medium. In step 230 of Fig. 2, Go teaches that "a blank portion on which new information may be recorded is selected from among the detected portions." (*See, e.g.,* lines 24-46 of column 2 of Go.)

Go is explicit that the blank portion of the recording medium to be used to for recording new information is “selected from among the detected portions.” There is no teaching that Go selects the first (or last for that matter) blank portion of the recorded medium to record the new information. On the contrary, Go, at lines 49-50 of column 2, teaches “the head is positioned at the starting point of the selected blank region” (emphasis added). Go does not teach that the head is position to the starting point of *any* blank region. As such, the principle of operation of Go is to scan an entire recording medium, detect control pulses that mark used portions of the recording medium, select a portion of the recording medium where no control pulses were detected, and position a recording head at the selected portion of recording medium to record new information.

At the top of page 4 of the pending Action, the Examiner states:

“Therefore in light of the teaching in Nagasawa it would have been obvious to one of ordinary skill at the time of the invention was made to modify Go by providing a deactivating operation at a time of detecting a pre-existing or pre-set signal in order to avoid loss of data.”

However, as noted above, the principle of operation of Go requires scanning an entire recording medium where pre-existing signals are detected prior to any deactivation. One of ordinary skill in the art at the time of the invention would not be motivated to modify Go with the teachings of Nagasawa as the Examiner asserts since modifying Go to deactivate recording at the time of occurrence of the detected control pulse, prior to scanning the entire medium, would change the principle of operation of Go.

MPEP §2143.01 states “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123

USPQ 349 (CCPA 1959). As such, the cited portions of the cited combination of Go and Nagasawa, as applied by the Examiner, do not establish a *prima facie* case of obviousness of independent Claim 1 and Claims that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 1, 3, and 5-7 and allow issuance thereof.

II. Rejection of Claims 1, 3, and 5-7 under 35 U.S.C. §103

The Examiner has rejected Claims 1, 3, and 5-7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,442,108 to Kurihara, *et al.* (hereinafter “Kurihara”) in view of Go and further in view of Nagasawa. As established above, the cited portions of the cited combination of Go and Nagasawa do not provide *prima facie* case of obviousness for independent Claim 1. Kurihara has not been cited to cure the above-noted deficiencies of the cited combination of Go and Nagasawa. As such, the cited portions of the cited combination of Kurihara, Go, and Nagasawa do not provide a *prima facie* case of obviousness for independent Claim 1 and Claims that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 1, 3, and 5-7 and allow issuance thereof.

III. Rejection of Claims 9, 11, 14, 16, 18, and 21 under 35 U.S.C. §103

The Examiner has rejected Claims 9, 11, 14, 16, 18, and 21 under 35 U.S.C. §103(a) as being unpatentable over Kurihara in view of Official Notice and further in view of Nagasawa. The Applicant respectfully disagrees.

At the middle of page 5 of the pending Action, the Examiner states “Claim 1 differs from Kurihara in that the claim further requires a record deactivation circuit to prevent recording on said

given magnetic storage media when said pre-existing electronic information signal detection element detects said pre-existing electronic information signal stored on said given magnetic storage media.” This implies that Kurihara does not teach a record deactivation circuit to prevent recording when a pre-existing electronic signal is detected. However, at the middle of page 7 of the pending Action, the Examiner states that Kurihara discloses “...detecting a pre-existing signal from the said given tape...” and “...deactivating a record circuit in the said cassette player.” This implies that Kurihara does teach a record deactivation circuit to prevent recording when a pre-existing signal is detected. In any case, the Applicant believes that the cited portions of Kurihara do not teach deactivating a record circuit when a pre-existing signal is detected as the Examiner recognizes on page 5 of the pending Action.

Kurihara teaches that a determination of whether a tape is blank is made based on whether a table of contents (TOC) exists or not. However, if there is not a TOC (indicating that the tape is blank), Kurihara does not teach to deactivate recording as the Examiner asserts. If there is not a TOC, Kurihara teaches recording in step S1-8. As such, Kurihara teaches that upon detection of a pre-existing signal (equated to as whether the tape is blank by the Examiner) recording is activated. Further, the Examiner states that “S1-6 and then S1-7 to S1-12 is not processed (not activated) if the tape is not a blank tape.” Fig. 6 of Kurihara teaches that if the tape is not a blank tape, then recording begins in step S1-15. Again, Kurihara teaches that upon detection of a pre-existing signal recording is activated.

As established above, Kurihara does not teach or suggest the limitation of deactivating a record circuit as detection of a pre-existing signal occurs as recited in pending independent Claims 9 and 16. Official Notice has not been cited to cure the above-noted deficiencies of Kurihara but to

assert that it is well known in the art at the time of the invention was made to record video signal in tape. Also, Nagasawa has not been cited to cure the above-noted deficiencies of Kurihara but to teach that the deactivating is performed at or about a time of occurrence of detection of a pre-existing signal. (*See* Examiner's Action of July 9, 2009, pages 7-8.) As such, Kurihara in combination with Official Notice and Nagasawa does not provide a *prima facie* case of obviousness for pending independent Claims 9 and 16 and Claims that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 9, 11, 14, 16, 18, and 21 and allow issuance thereof.


IV. Conclusion

In view of the foregoing remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1, 3, 5-7, 9, 11, 14, 16, 18 and 21.

The Applicant requests the Examiner to telephone the undersigned agent of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, P.C.

A handwritten signature in black ink, appearing to read "Steven J. Hanke". The signature is written in a cursive, flowing style.

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